

APPENDIX D: EXCERPT FROM RESPONSE TO OFFICE ACTION DATED
JULY 9, 2003, FILED NOVEMBER 10, 2003

Claims 18-20 and 46-48 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10 and 38, and further in view of US Patent No. 4,789,895 (hereinafter Mustafa).

2. **Response to § 251 Rejection**

The Applicants respectfully disagree that the claims identified under this rejection constitute "an improper recapture of broadened claimed subject matter surrendered in the application for the patent on which the present reissue is based" (Office Action, page 2). The Applicants respectfully disagree that any broadening aspects of the reissue claims are related to subject matter that the Applicants previously surrendered, during the prosecution of U.S. Patent No. 5,819,034 (the '034 patent). The Applicant's reasons in connection with this position are set out more fully below.

A failure of a patentee (or a patentee's attorney) to appreciate the full scope of the invention during the prosecution of the original patent application is well recognized as an error correctable by a broadening reissue. See Amos, 953 F.2d at 616, 21 USPQ2d at 1273; In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of § 251. See Clement, 131 F.3d at 1468, 45 USPQ2d at 1163; Wilder, 736 F.2d at 1519, 222 USPQ at 371.

Broadening reissues are subject to the "recapture rule", which is discussed in Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The recapture rule "prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims." Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1525.

The Federal Circuit, in Clement, 131, F. 3d 1464, 1468-70, 45 USPQ2 at 1161, 1163-65 (Fed. Cir. 1997), stated that an analysis under the recapture rule includes a four-step analysis, namely:

1. Determining whether and in what “aspects” the reissue claims are broader than the claims of the issued patent. A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. See id.
2. Determining whether the broader aspects of the reissue claims relate to surrendered subject matter. “To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.” See id. at 1469, 45 USPQ2d at 1164.
3. Determining whether the surrendered subject matter has “crept” into the reissue claims.
4. Determining whether the reissue claims are materially narrowed, relative to the claims of the issued patent, in other respects, with a view to determining whether the recapture may be avoided. For example, in Ball Corp. v. United States, the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as “fundamental narrowness”) despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296.

Applying the above discussed analysis under the recapture rule to the claims of the present reissue application, it is apparent that the reissue claims are broader than the issued claims of the ‘034 patent in certain aspects, but also narrower relative to the issued

claims in other respects. Specifically the claims of the present reissue application are directed to facilitating ordering an item using a distributed computer system.

Accordingly, limitations of at least the independent claims of the present reissue application are absent from the independent claims of the '034 patent. Consider, for example, the first limitation of independent claim one of the '034 patent, which requires the following:

A source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted. (034 patent, column 14, lines 37-45).

Clearly, claim 10 of the present reissue application does not include a limitation corresponding to the above-identified limitation of claim 1 of the '034 patent, and claim 10 of the present reissue application is accordingly broader in this respect.

On the other hand, consider the following limitation of claim 10 of the reissue claims:

Enabling the user to place an order for the item with a single action with respect to the client, while the item is being offered for sale, the single action being in connection with the order.

The issued claims of the '034 patent do not include a limitation corresponding to the above-identified limitation of claim 10 of the reissue application. In this respect, claim 10 of the reissued claims has been materially narrowed, relative to the claims of the '034 patent. The Applicants believe that this constitutes what is identified as a

“fundamental narrowness”, identified in Ball Corp., which avoids the recapture rule, despite broadened aspects of the claims.

Further, as limitations of the issued claims of the ‘034 patent are not present in the reissue claims, the Applicants believe that the broader aspects of the reissue claims (i.e., the aspects corresponding to limitations in the ‘034 patent that are absent in the independent claims of the current reissue application) do not relate to surrendered subject matter. This is because the Applicants could not, by way of argument or amendment, surrender subject matter corresponding to the limitations of the present reissue claims in view of the absence of these limitations from the issued claims of the ‘034 patent. Consider for example that the claims of the ‘034 patent do not include any limitations directed to enabling “the user to place an order for an item by a single action.” Accordingly, the opportunity did not arise during the prosecution of the ‘034 patent for the Applicants to in fact surrender subject matter pertaining to this limitation. In short, the subject matter of the independent claims of the current reissue application is different from the subject matter of the issue claims of the ‘034 patent, and the question of recaptured subject matter does not arise. This dovetails with the above position that the reissue claims are sufficiently narrowed, despite the broadened aspects of the claims, so as to avoid the recapture rule.

In conclusion, the Applicants believe that the rejection under 35 U.S.C. § 251 has been fully addressed, and withdrawal of this rejection is requested.

The Applicants note that the Office Action states that “[a]t a minimum, the claims require at least one of the following limitations which were argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,098 application”, whereafter the limitations of the identified independent claims are listed (Office Action, pages 3-5). The Applicants fail to fully understand the reason for this alleged requirement. The Applicants also draw the Examiner’s attention to the co-pending divisional reissue application serial number 09/903,458, in which claims corresponding to the issued claims of the ‘034 patent are presented. It will be recalled that, on the

suggestion of the Examiner, a number of divisional reissue applications were filed based off the current reissue application, each of these divisional applications including claims that were originally included in the current reissue application. Claims corresponding to the claims of the divisional reissue applications were then cancelled from the current reissue application, by way of a preliminary amendment dated April 13, 2001.

By requiring that a limitation in the claims of the '034 be present in the claims of the present reissue application, we speculate that reference is being made to the "original invention" requirement. We below quote the pertinent section (1412.01) from the MPEP:

1412.01 Reissue Claims Must Be for Same General Invention

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does not mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the original patent." *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The "original patent" requirement of 35 U.S.C. 251 must be understood in light of *In re Amos*, *supra*, where the Court of Appeals for the Federal Circuit stated:

We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if

the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

953 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

(MPEP 1412.01, Emphasis Added)

The claims of the present reissue application are clearly described in the original patent specification for the '034 patent, and are likewise enabled by the original patent specification for the '034 patent, such that 35 U.S.C. § 112, first paragraph, is satisfied.

Further, there is nothing in the original patent specification for the '034 patent which indicates an intent not to claim the subject matter of the claims of the present reissue application.

In short, the Applicants do not believe that a limitation from the issued independent claims of the '034 patent is required within the independent claims of the present reissue application in order to satisfy the "original invention" requirement.

3. Response to § 112 Rejection

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

The Examiner is thanked for identifying this error in the dependency of claim 17. The Applicants have amended claim 17 to be dependent upon claim 10, as correctly assumed by the Examiner.

4. Response to § 103 Rejections

The Applicants respectfully traverse these rejections for the reasons set out below, and ask the Examiner for reconsideration. The Applicants have further also slightly amended the claims to define clearly the intended import of the claims.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the